

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/931,064

PATENT APPLICATION
Atty Docket No. Q63766

REMARKS / REQUEST FOR RECONSIDERATION

Claims 1 - 20 were previously pending in the application. Claim 14 is herein cancelled. Therefore, claims 1 - 13 and 15 - 20 are presently pending in the application.

Because the claim amendments presented herein reduce issues on appeal, entry of the same is respectfully requested. Additionally, in view of the below discussion, the Examiner is respectfully requested to reconsider the rejections made in the May 5, 2004, Office Action.

I. Rejection of Claim 14 Under 35 U.S.C. § 112, Second Paragraph, and 35 U.S.C. § 103

Claim 14 is rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. Claim 14 is also rejected under 35 U.S.C. § 103 in view of a combination of Hayakawa (U.S.P. No. 6,365,909), Torii (U.S.P. No. 4,810,874) and Heffelfinger (U.S.P. No. 6,043,506).

Claim 14 is herein cancelled, obviating the noted rejections.

II. Rejection of Claims 1 – 4, 7 – 11 and 17 - 18 Under 35 U.S.C. § 103

Claims 1 – 4, 7 – 11, 17 and 18 stand rejected under 35 U.S.C. § 103 in view of a combination of Hayakawa (U.S.P. No. 6,365,909) and Torii (U.S.P. No. 4,810,874). This rejection is respectfully overcome because: i) the cited references are an invalid combination / there is a lack of proper motivation to combine the cited references, and ii) the cited art fails to teach or suggest all of the features of Applicant's independent claims. These issues are discussed in turn, below.

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The Hayakawa and Torii References are an Improper Combination / Lack of Proper Motivation to Combine the Cited References

The Hayakawa and Torii references are an improper combination because “the references teach away from their combination [,]” and therefore violate M.P.E.P. § 2145(X)(D)(2). To explain in greater detail, Torii declares as a primary objective that its invention “conducts image read-out without taking the [phosphorous] sheet out of the cassette . . .” *See Column 2, approximately lines 30 – 33.* The stated advantage for doing so is to prevent damage from occurring to the phosphorous sheet. *See Column 2, approximately lines 15 – 24.*

In contrast, *all* embodiments of the Hayakawa device require that the phosphor sheet be removed from the container/cassette for stimulation and reading. For instance, *see Column 4, approximately lines 22 – 24, “. . . an apparatus main body which takes the storage phosphor plate out of the cassette . . .”* *See also:* Column 5, line 63, to Column 6, line 15; Column 6, lines 36 – 38 and lines 45 – 47; Column 7, lines 6 – 8, lines 28 – 30, lines 49 – 51 and lines 54 – 55; *among others.*

Therefore, because Torii requires that the sheet remain in the cassette, while Hayakawa requires that the sheet be taken out of the cassette, the references specifically teach away from the Examiner’s attempt to combine the two, and the attempt to combine is thus improper. In light of the fact that the combination violates the mandate of M.P.E.P. § 2145(X)(D)(2), the Examiner is respectfully requested to reconsider and withdraw this rejection.

The Prior Art Fails to Teach or Suggest All of the Features of Applicant’s Independent Claims

Furthermore, even if Hayakawa and Torii could be properly combined (which, as explained above, they cannot), the cited art fails to teach or suggest all of the features of

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Applicant's independent claims. The Examiner compares the elements of Hayakawa's Figure 25 to certain features recited by Applicant's claim 1. Such a comparison is inapposite because Applicant's claim 1 includes (in paraphrase) the recitation of the phosphorous sheet being contained in a container while being on top of the support table. These features are absolutely absent from the Hayakawa reference, let alone Figure 25 of the Hayakawa reference.

In comparison to Applicant's independent claim 1, Hayakawa's phosphorous sheet 12 is *removed from a container* and then laid directly on support 4. That is, Hayakawa's application of excitation light, and reading of subsequent emitted light, *occurs while the phosphor sheet is not in a container, but is instead on a support*. See Hayakawa at Column 13, lines 1 – 33; see also Figure 25.

In contrast, Applicant's independent claim 1 recites (in paraphrase) that the phosphor sheet remains in the container for application of the excitation light, as well as for the reading of emitted light.

As explained above, Hayakawa is absolutely deficient, and the Examiner's reliance thereon is therefore likewise deficient. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection at least because Hayakawa fails to teach or suggest the noted aspects of Applicant's independent claim 1 as alleged by the Examiner.

Furthermore, Torii is completely different from Applicant's independent claim 1, which recites (in paraphrase) that the phosphor sheet is housed in a container, and that the container is held in place by a support table. In contrast, Torii does not include a support table, but uses a

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conveyor 30 which moves a cassette (see Fig. 2). A conveyor is not the same thing as a support table.

Moreover, the Torii reference absolutely fails to disclose that the stimulating light applying means and the light collecting means are displaceable, as is recited by Applicant's independent claim 1. Additionally, while Hayakawa may disclose that the stimulating light apply means and light collecting means are displaceable in an embodiment of the Hayakawa device where the phosphor sheet is hung vertically (*see, e.g.*, Fig. 13, elements 5, 500, 501; and Col. 21, lines 54 – 61), Hayakawa is absolutely deficient in teaching or suggesting displaceable stimulating light applying means and/or displaceable light collecting means when the phosphor sheet is placed horizontally.

In stark contrast, Applicant's independent claim 1 recites (in paraphrase) that the phosphor sheet lies horizontally in a container on a support table and that the stimulating light applying means and the light collecting means displace above the phosphor sheet. Therefore, because Hayakawa only discloses vertically displaceable light collecting and light stimulating means, and further because Torii is absolutely silent as to displaceable light stimulating and/or light collecting means, the rejection is improper and should be withdrawn.

Summary as to Applicant's Independent Claim 1

In summary, at least for the previous reasons, claim 1 is patentable over the Hayakawa and Torii references. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 1.

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Additionally, Applicant asserts that claims 2 – 20 are patentable at least because “[i]f an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” See M.P.E.P. § 2143.03 (*citing to In re Fine*, 837 F.2d 1071 (Fed Cir. 1988)).

III. Rejection of Claims 5 – 6, 15 – 16 and 20 Under 35 U.S.C. § 103

Claims 5, 6, 15, 16, and 20 are rejected under 35 U.S.C. § 103 in view of a combination of Hayakawa (U.S.P. No. 6,365,909), Torii (U.S.P. No. 4,810,874), and Schneider (U.S.P. No. 4,965,455). This rejection is respectfully traversed as follows.

As noted above, Hayakawa and Torii are both deficient. Schneider fails to cure the deficiencies of Hayakawa and Torii. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

IV. Rejection of Claims 12 – 13 and 19 Under 35 U.S.C. § 103

Claims 12, 13 and 19 are rejected under 35 U.S.C. § 103 in view of a combination of Hayakawa (U.S.P. No. 6,365,909), Torii (U.S.P. No. 4,810,874), and Watanabe (U.S.P. No. 4,733,307). This rejection is respectfully traversed as follows.

As noted above, Hayakawa and Torii are both deficient. Watanabe fails to cure the deficiencies of Hayakawa and Torii. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: August 3, 2004

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT UNDER 37 C.F.R. § 1.116 is being facsimile transmitted to the U.S. Patent and Trademark Office this 3rd day of August, 2004.


Thea Wagner